

REMARKS

Claims 1-29 are pending in the present application. In the above amendments, claims 1, 10, 12, 16-17, 19, 25-26, and 28-19 have been amended, and claims 4-6, 13-15, and 22-24 have been cancelled without prejudice.

In the Office Action mailed by the Examiner on April 9, 2007 the Examiner rejected claims 1-3, 6, 9-12, 15, 18-21, 24, and 27-29 as being anticipated by U.S. 6,646,561 to Zur ("Zur Patent") under 35 U.S.C. §102(e), and claims 4, 13, 22 under 35 U.S.C. §103(a) as unpatentable for obviousness over the Zur Patent; and claims 5, 7, 8, 14, 16, 17, 23, 25 and 26 under 35 U.S.C. §103(a) as unpatentable for obviousness over the Zur Patent in view of a published U.S. patent application No. U.S. 2006/0052918 to McElod, et al. ("Published McElod Application").

Applicant respectfully responds to the Office Action, and requests withdrawal of the rejections for at least the following reasons:

A. On pages 2-3 of the Office Action, paragraph 2, the Examiner rejected claims 1-3, 6, 9-12, 15, 18-21, 24, and 27-29 as being anticipated by U.S. 6,646,561 to Zur ("Zur Patent") under 35 U.S.C. §102(e).

Applicant, however, has amended independent claims 1, 10, 19, and 28 to improve the clarity, readability, and/or understanding of the application and of the invention, while adding no new matter. The claim amendments to the independent claims overcome any basis for continued argument in support of anticipation by the Zur Patent.

In addition, the Zur Patent does not satisfy the "all-elements" rule of MPEP §2131, which provides:

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference. . The identical invention must be shown in as complete detail as contained in the claim ... [and] the elements must be arranged as required in the claim. (Emphasis added.)

Accordingly, the invention of the present application was not described in an application for patent...by another filed in the United States before the invention by the applicant for patent, as required by 35 U.S.C. §102(e).

More specifically, as the Examiner concedes on page 4 of the Office Action, the Zur Patent does not disclose that reference parameters are determined by averaging prior battery characteristics from one or more starting events. That omission, however, is not the only difference between the application and the Zur Patent. Indeed, the Zur Patent reinforces and demonstrates the novelty of the present invention, and why the claimed recitations of the present invention are superior to the disclosure of the Zur Patent.

For example, as expressly stated in the Zur Patent, the method of the Zur Patent claims the step of "sensing at least one engine characteristic selected from the group consisting of engine noise and engine vibration...." see Zur Patent, column 39, subparagraph element (f), lines 14-16. The present invention, however, compares battery characteristics to stored reference parameters derived from prior starting events that include engine temperature, ambient temperature, battery type, and vehicle type, rather than engine noise and engine vibration.

Furthermore, the Zur Patent does not disclose or claim the feature and capability claimed in the present invention to download reference parameters from a remote station. One desirable feature of the present invention, among others, is that the detection system disclosed and claimed in the Application communicates through a satellite-based wireless communication channel to a diagnostic station. see Application, page 4, paragraph [1020]. Thus, unlike the features and capabilities of the Zur Patent, the present invention is operable through a mobile communication terminal for communicating with one or more remote locations using a satellite-based wireless communication system. The mobile communications terminal resides on board a vehicle so as to be easily accessible by the vehicle operator. See Application, page 5, paragraph [1021]. The communications system provides two-way communication between a vehicle and a remote diagnostic station. The vehicle also may comprise other wireless systems that could be used in addition to, or in the alternative to, a satellite system. See Application, page 5, [1022]. None of the features of a wireless communication system over which data concerning a battery may be received, transmitted and stored is disclosed or claimed in the Zur Patent.

B. In the Office Action mailed by the Examiner on April 9, 2007 the Examiner rejected claims 4, 13, 22 under 35 U.S.C. §103(a) as unpatentable for obviousness over the Zur Patent; and claims 5, 7, 8, 14, 16, 17, 23, 25 and 26 under 35 U.S.C. §103(a) as unpatentable for

obviousness over the Zur Patent in view of a published U.S. patent application No. U.S. 2006/0052918 to McElod, et al. ("Published McElod Application").

Applicant, however, has established that the Zur Patent, the base or primary reference for the obviousness rejection, does not satisfy the requirements for anticipation of the present invention. Accordingly, the Zur Patent itself cannot be a single-reference basis for rejection, and does not support a *prima facie* argument of obviousness because the Zur Patent does not disclose each and every limitation found in the rejected claims, as currently presented, and therefore the claims are in condition for allowance.

Furthermore, the Zur Patent in combination with the published McElod Application cannot be combined to support a *prima facie* argument of obviousness because the primary reference, the Zur Patent, not only fails to disclose the limitations found in the rejected claims as currently presented, but also because the claims rejected under 35 U.S.C. §103(a) are all dependent claims.

Because the independent claims now are patentable, it follows that dependent claims rejected over the Zur Patent, or over the Zur Patent in view of published McElod application, are patentable because the Zur Patent fails to satisfy the requirements of MPEP §2143.03, which provides that if an independent claim is nonobvious under §103, then any claim depending therefrom also is nonobvious. see also *In re Fine*, 837 F. 2nd 1071, 5 USPQ 2d 1596, (Fed. Cir. 1988).

C. On page four of the Office Action, the Examiner advances the argument that although the Zur Patent does not disclose that reference parameters are determinable by averaging prior battery characteristics from one or more prior starting points, it would have been in the opinion of the Examiner obvious to one of ordinary skill at the time of the invention to use a reference parameter that reflects an average of the battery characteristics from prior starting events as, "supposedly, these prior starting events would reflect a battery characteristic that is considered to be a normal value of a fully functional battery."

Since the date of the Examiner's office action the U.S. Supreme Court issued its opinion in *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007) ("KSR Opinion"). On May 3, 2007 the Commissioner sent a memorandum to the Technology Center Directors ("Memorandum") that the KSR Opinion (a) reaffirmed the *Graham* factors, (b) did not reject the use of "teaching, suggestion, or motivation" ("TSM Test") as a factor in the obviousness analysis,

but merely rejected a rigid application of the TSM Test, and (c) reaffirmed the need to make explicit reasons that would have prompted a person of ordinary skill in the art to combine the prior art elements in the manner suggested by an Examiner. The Examiner has not offered explicit reasons why a person of ordinary skill in the art would seek to combine the references as suggested by the Examiner. Accordingly, Applicant submits that a *prima facie* case for obviousness does not arise from a combination of the references cited by the Examiner.

Drawings

Applicant files no amended drawing figures herewith.

Specification


Applicant provides no amendments to the specification.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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